

26  
cancel

26  
29. The method of claim ~~23~~<sup>20</sup>, wherein the mammal is a human. --

## **REMARKS**

Claims 2-17, 19-21, and 23-29 are pending upon entry of the foregoing amendments. Claims 1, 18, and 22 have been canceled. Claims 2, 5-8, 10-13, 19-21, and 23-26 have been amended. Claims 27-29 have been added. Claims 2, 19, and 23 are independent claims. The amendments and newly added claims do not include new matter, as indicated in the following section. No additional claim fee is believed to be due, three claims having been cancelled, and three dependent claims having been added.

### **Support in the Specification**

Claims 2, 19, and 23 have been amended to incorporate the recitations of originally-filed claims 1, 18, and 22, respectively, from which the claims previously depended.

Claims 5-8, 10-13, 20, and 24 have been amended simply to change their dependency from a canceled claim to one of independent claims 2, 19, and 23. Claim 10 has also been amended to provide better syntax.

Claim 21 has been amended to recite the selection of the second nucleic acid according to the method of claim 19.

Claim 25 has been amended to recite the selection of nucleic acids by the method of claim 19 and incorporation of the selected nucleic acids into an array. This recitation is supported by claim 18 as initially filed and in the specification, for example in paragraph [0088].

Claim 26 has been amended to recite that the instructional material describes the use of the kit components for performing the method of claim 2. This amendment is supported in the specification, for example, in paragraph [0055].

Newly added claims 27-29, respectively depending from claims 19, 21, and 23, simply repeat the recitation of originally filed claim 5, namely that the mammal recited in the claim from which the new claim depends is a human.

For the reasons set forth in this section, the Applicants respectfully contend that the amendments made herein do not include new matter.

### Information Disclosure Statement

An Information Disclosure Statement and a copy of each of the references cited therein are enclosed. Consideration and acknowledgment of the references are requested.

### Objection to Claims 2-4, 19, and 23

The Examiner objects to claims 2-4, 19, and 23 as being dependent upon a rejected base claim and indicates that these claims would be allowable if rewritten in independent form. Claims 2, 19, and 23 have been so amended, and the Applicants respectfully contend that each of claims 2-4, 19, and 23 is in condition for allowance.

### Rejection of Claims 1, 5-7, 10, 12, 18, 21, and 22 Pursuant to 35 U.S.C. § 102(e)

The Examiner rejects claims 1, 5-7, 10, 12, 18, 21, and 22 pursuant to 35 U.S.C. § 102(e) as being anticipated by Falb.

Each of the pending independent claims has been amended to be allowable, as noted above in the section relating to the objection to claims 2-4, 19, and 23, and each of the dependent claims depends from a now-allowable independent claim. Therefore, all claims should be in condition for allowance.

For the foregoing reasons, the Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 5-7, 10, 12, and 21, pursuant to 35 U.S.C. § 102(e).

### Rejection of Claims 1, 8, 9, 11, 13-18, 20, 22, 24, and 26 Pursuant to 35 U.S.C. § 103(a)

The Examiner rejects claims 1, 8, 9, 11, 13-18, 20, 22, 24, and 26 pursuant to 35 U.S.C. § 103 (a) as being unpatentable over Falb in view of Eberwine.

Each of the pending independent claims has been amended to be allowable, as noted above in the section relating to the objection to claims 2-4, 19, and 23, and each of the dependent claims depends from a now-allowable independent claim. Therefore, all claims should be in condition for allowance.

With regard to claim 26, the Examiner contends that grouping reagents into a kit was known prior to the invention. Amended claim 26 recites that the kit includes an instructional material that describes use of the kit for performing the method of claim 2. The Applicants respectfully contend that because claim 2 recites a novel method, it would not have been obvious for a skilled artisan to compose a kit with instructions communicating the usefulness of the kit components in practicing such a method.

For this reason, the Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 8, 9, 11, 13-17, 20, 24, and 26 pursuant to 35 U.S.C. § 103(a).

Rejection of Claim 25 Pursuant to 35 U.S.C. § 112, First Paragraph

The Examiner rejects claim 25 pursuant to 35 U.S.C. § 112, first paragraph. The Examiner suggests that the specification does not indicate that the Applicants were in possession of the invention of claim 25 at the time the application was filed. Originally filed claim 25 was directed to an array comprising nucleic acids. As amended, claim 25 recites a method of making such an array, and depends from claim 19. The Applicants understand the Examiner's rejection to relate to whether or not relevant nucleotide sequences were disclosed in the application. Because claim 25, as amended, does not require a description of such sequences (i.e., they are the sequences of nucleic acids identified using the method in claim 19), the Applicants respectfully contend that the Examiner's rejection pursuant to 35 U.S.C. § 112, first paragraph, is inapplicable to amended claim 25. Reconsideration and withdrawal of the rejection are respectfully requested.

Summary

The Applicants contend that each of the Examiner's rejections has either been overcome or been shown to be inapplicable to the pending claims. Reconsideration and allowance of claims 2-17, 19-21, and 23-29 are respectfully requested at the earliest possible time.

Respectfully submitted,

**PETER F. DAVIES ET AL.**

17 December 2001

(Date)

By: 

**GARY D. COLBY, Ph.D., J.D.**

Registration No. 40,961

**AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.**

One Commerce Square

2005 Market Street - Suite 2200

Philadelphia, PA 19103-7086

Telephone: 215-965-1200

**Direct Dial: 215-965-1285**

Facsimile: 215-965-1210

E-Mail: gcolby@akingump.com

ASN:GDC:KMP/cc

Enclosures: Petition for Extension of Time  
Marked-Up Copy of Claims, as Amended  
Clean Copy of Claims, as Amended  
Information Disclosure Statement and cited references